

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 55-79 are pending in the application, with claims 55 and 71 being the independent claims. Claims 55-70 have been allowed. The amendment to claim 71 is sought to exclude subject matter from this claim. Hence, this amendment introduces no new matter, and its entry and consideration are respectfully requested.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

In the Office Action at page 3, the Examiner has rejected claims 71-79 under 35 U.S.C. §102(b) as being anticipated by Chamberlin *et al.* (WO 95/20682). Applicants respectfully traverse this rejection.

Applicants note that the Patent and Trademark office (through the Examiner) bears the initial duty of supplying the factual basis for supporting a rejection of a patent application, including a rejection based on anticipation. *In re Wagner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *see also In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992). "It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office." *In re Skinner*, 2 USPQ2d 1788, 1788-89 (B.P.A.I. 1986). To establish a *prima facie* case of

anticipation, the Examiner must demonstrate that a single prior art reference teaches each and every element of a claim. *See* M.P.E.P. § 2131 at 2100-70, Eighth ed., rev. February 2003. The Examiner has not met this burden.

The Examiner states that "Chamberlin *et al.* discloses the addition of osmolytes such as dimethyl glycine, to sequencing reactions and PCR as they are known to destabilize double-stranded DNA, thereby lowering the T_m of the DNA analyzed." Office Action at page 3, section 4. Claims 71-77 of the present application do not recite osmolytes or dimethyl glycine. Furthermore, the Examiner has not shown that all other elements of claims 71-79 are disclosed in Chamberlin. Therefore, a *prima facie* case of anticipation has not been established by the Examiner.

Nevertheless, to expedite prosecution Applicants have amended claim 71 to recite "wherein said amino acid is not methylglycine and is not dimethylglycine." Therefore, claim 71 is not anticipated by Chamberlin. Furthermore, because claims 72-79 depend either directly or indirectly from claim 55 or claim 71, and claims 55 and 71 are not anticipated by Chamberlin, claims 72-79 cannot be anticipated.

Applicants respectfully request for reconsideration and withdrawal of this rejection.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants

believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "B. Del Buono", with a stylized flourish at the end.

Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

Date: Aug. 21, 2003

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600